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ROPES & GRAY LLP PATENT DOCKETING 39/361 1211 AVENUE OF THE AMERICAS NEW YORK, NY 10036-8704			EXAMINER SHEPARD, JUSTIN E	
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

09/821,005

**Applicant(s)**

ELLIS ET AL.

**Examiner**

Justin E. Shepard

**Art Unit**

2424

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 04 September 2008.  
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1, 2, 5-17, 24-30, 33-35, 38-45 and 52-68 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1, 2, 5-17, 24-30, 33-35, 38-45 and 52-68 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 10/22/08.  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_  
5) ☐ Notice of Informal Patent Application  
6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Arguments***

Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1, 29, 59, 60, 61, 62, 64, 65, 66, and 67 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims 1 and 29 contain the limitation of "programs that have subject matter similar to subject matter of the selected program" could not be found in the applicant's specification.

Claims 59 and 64 contain limitations that could not be found in the applicant's specification.

Claims 60 and 65 contain limitations that could not be found in the applicant's specification.

Claims 61, 62, 66, and 67 contain the limitation of "programs associated with a particular broadcast interval" could not be found in the applicant's specification.

### ***Claim Objections***

Claims 59 and 64 are objected to because of the following informalities: The claim refers to previous programs that are scheduled to be broadcast at the same time and channel as the selected program, but if the program is being broadcast on the same time and channel, it would be the same exact program. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2, 5, 7, 10-12, 24-30, 33, 35, 38-41, 43, 44, and 52-68 are rejected under 35 U.S.C. 103(a) as being unpatentable over Agnihotri in view of Inoue in view of Herald.

Referring to claim 1, Agnihotri discloses a method for use in a recording system for reducing cut-offs when programs are recorded (column 3, lines 36-45), the method comprising:

receiving at the user equipment a user selection of a program to record (column 1, lines 16-20);

predicting by the user equipment a time change associated with the selected program (column 3, lines 36-45 and 59-63; column 4, lines 6-14);

recording by the user equipment the selected program to compensate for a time change based on the predicted time change (column 5, lines 20-32).

Agnihotri does not disclose a system wherein the time change is based on time changes for previous programs related to the program; and

wherein related programs have subject matter similar to subject matter of the selected program.

In an analogous art, Inoue teaches a system wherein the predicted time change is based on time changes for previous programs related to the program (figures 6A and 6B).

At the time of the invention, it would have been obvious for one of ordinary skill in the art to add the method of modifying the recording of the adjacent program when the first program is extended. The motivation would have been that if a baseball game is extended, the program following the program would have to be clipped as there would be no way to record it fully without a second tuner.

Agnihotri and Inoue do not disclose a method wherein related programs have subject matter similar to subject matter of the selected program.

In an analogous art, Herald teaches a method wherein related programs have subject matter similar to subject matter of the selected program (column 1, lines 32-41).

At the time of the invention, it would have been obvious for one of ordinary skill in the art to note that channel 1 from figure 6A in Inoue could be broadcasting the baseball double header taught by Herald. This would mean that if baseball game ABC vs. XYZ went extra innings and ran over its allotted time slot that the following game would need its recording time adjusted using the prediction from Agnihotri. The motivation would have been that it would be beneficial to broadcast more sports to bring in more money from commercials inserted into the broadcasts.

Claim 29 is rejected on the same grounds as claim 1.

Referring to claim 2, Agnihotri discloses a method of claim 1 wherein the predicted time change comprises predicted time delay information (column 3, lines 36-45).

Claim 30 is rejected on the same grounds as claim 2.

Referring to claim 5, Agnihotri discloses a method of claim 2 wherein the predicted time delay information is based on previously logged time changes (column 8, lines 5-13).

Claims 10 and 33 are rejected on the same grounds as claim 5.

Referring to claim 6, Agnihotri does not disclose a method of claim 1 further comprising displaying a predicted time delay information for the selected program.

In an analogous art, Inoue teaches a method of claim 1 further comprising displaying a predicted time delay information for the selected program (figure 14, parts 37 and 38).

At the time of the invention, it would have been obvious for one of ordinary skill in the art to add the overlapping recording display to the system disclosed by Agnihotri. The motivation would have been to enable the user to select which program to clip when the system is not confident about the choice (Agnihotri: column 7, lines 22-27).

Claim 34 is rejected on the same grounds as claim 6.

Referring to claim 7, Agnihotri discloses a method of claim 1 wherein the predicted time change comprises predicted time extension information (column 3, lines 36-45).

Claims 11 and 35 are rejected on the same grounds as claim 7.

Referring to claim 12, Agnihotri discloses a method of claim 1 further comprising providing a user with an opportunity to select a recording start time (column 1, lines 16-20).

Referring to claim 15, Agnihotri discloses a method of claim 1 further comprising providing a user with an opportunity to select a recording end time (column 1, lines 16-20).

Referring to claim 24, Agnihotri does not disclose a method of claim 1 further comprising displaying an icon in a program listing for the selected program to indicate that the predicted time change is available.

In an analogous art, Inoue teaches a method of claim 1 further comprising displaying an icon in a program listing for the selected program to indicate that the predicted time change information is available (figure 14, parts 37 and 38).

At the time of the invention, it would have been obvious for one of ordinary skill in the art to add the overlapping recording display to the system disclosed by Agnihotri. The motivation would have been to enable the user to select which program to clip when the system is not confident about the choice (Agnihotri: column 7, lines 22-27).

Claim 52 is rejected on the same grounds as claim 24.

Referring to claim 25, Agnihotri does not disclose a method of claim 1 further comprising displaying an icon in a program listing for the selected program that indicates that the program is to be recorded.

In an analogous art, Inoue teaches a method of claim 1 further comprising displaying an icon in a program listing for the selected program that indicates that the program is to be recorded (figure 14, parts 37 and 38).

At the time of the invention, it would have been obvious for one of ordinary skill in the art to add the overlapping recording display to the system disclosed by Agnihotri. The motivation would have been to enable the user to select which program to clip when the system is not confident about the choice (Agnihotri: column 7, lines 22-27).



Claim 53 is rejected on the same grounds as claim 25.

Referring to claim 26, Agnihotri does not disclose a method of claim 1 further comprising trimming a recording time of the selected program or an adjacent program to reduce the cut-off in a program recording.

In an analogous art, Inoue teaches a method of claim 1 further comprising trimming a recording time of the selected program or an adjacent program to reduce the cut-off in a program recording (figures 6A and 6B).

At the time of the invention, it would have been obvious for one of ordinary skill in the art to add the method of modifying the recording of the adjacent program when the first program is extended. The motivation would have been that if a baseball game is extended, the program following the program would have to be clipped as there would be no way to record it fully without a second tuner.

Claim 54 is rejected on the same grounds as claim 26.

Referring to claim 27, Agnihotri discloses a method of claim 26 wherein trimming the recording time comprises trimming based on a confidence level in time change information for the selected program and the adjacent program (column 7, lines 54-61).

Claim 55 is rejected on the same grounds as claim 27.

Referring to claim 28, Agnihotri discloses a method of claim 27 wherein trimming comprises trimming a time changed recording time of the selected program when time

change information for the selected program has a lower confidence level than the adjacent program (column 7, lines 54-61; column 8, lines 22-27).

Claim 56 is rejected on the same grounds as claim 28.

Referring to claim 40, Agnihotri does not disclose a user recording equipment of claim 29 wherein the control circuitry provides a user with an opportunity to select a recording start time to compensate for the time change.

In an analogous art, Inoue teaches a user recording equipment of claim 29 wherein the control circuitry provides a user with an opportunity to select a recording start time to compensate for the time change (figure 14, parts 37 and 38).

At the time of the invention, it would have been obvious for one of ordinary skill in the art to add the overlapping recording display to the system disclosed by Agnihotri. The motivation would have been to enable the user to select which program to clip when the system is not confident about the choice (Agnihotri: column 7, lines 22-27).

Referring to claim 41, Agnihotri does not disclose a user recording equipment of claim 29 wherein the control circuitry automatically selects a recording start time to compensate for the time change.

In an analogous art, Inoue teaches a user recording equipment of claim 29 wherein the control circuitry automatically selects a recording start time to compensate for the time change (figures 6A and 6B).

At the time of the invention, it would have been obvious for one of ordinary skill in the art to add the method of modifying the recording of the adjacent program when the first program is extended. The motivation would have been that if a baseball game is extended, the program following the program would have to be clipped as there would be no way to record it fully without a second tuner.

Referring to claim 43, Agnihotri does not disclose a user recording equipment of claim 29 wherein the control circuitry provides the user with an opportunity to select a recording end time to compensate for the time change.

In an analogous art, Inoue teaches a user recording equipment of claim 29 wherein the control circuitry provides the user with an opportunity to select a recording end time to compensate for the time change (figure 14, parts 37 and 38).

At the time of the invention, it would have been obvious for one of ordinary skill in the art to add the overlapping recording display to the system disclosed by Agnihotri. The motivation would have been to enable the user to select which program to clip when the system is not confident about the choice (Agnihotri: column 7, lines 22-27).

Referring to claim 44, Agnihotri discloses a user recording equipment of claim 29 wherein the control circuitry automatically selects a recording end time to compensate for the time change.

In an analogous art, Inoue teaches a user recording equipment of claim 29 wherein the control circuitry automatically selects a recording end time to compensate for the time change (figures 6A and 6B).

At the time of the invention, it would have been obvious for one of ordinary skill in the art to add the method of modifying the recording of the adjacent program when the first program is extended. The motivation would have been that if a baseball game is extended, the program following the program would have to be clipped as there would be no way to record it fully without a second tuner.

Referring to claim 57, Agnihotri discloses a method of claim 1 further comprising allowing the user to change the predicted time change (column 8, lines 22-27).

Claim 58 is rejected on the same grounds as claim 57.

Referring to claim 59, Agnihotri does not disclose a method of claim 1, wherein the predicted time change is based on time changes for previous programs that are scheduled to be broadcast on the same channel and at the same time as the selected program.

In an analogous art, Inoue teaches a method of claim 1, wherein the predicted time change is based on time changes for previous programs that are scheduled to be broadcast on the same channel and at the same time as the selected program (figures 6A and 6B; Note: if Drama: Detective 0 were being recorded they would have been scheduled for the same time and channel (21:00)).

At the time of the invention, it would have been obvious for one of ordinary skill in the art to add the method of modifying the recording of the adjacent program when the first program is extended. The motivation would have been that if a baseball game is extended, the program following the program would have to be clipped as there would be no way to record it fully without a second tuner.

Claim 64 is rejected on the same grounds as claim 59.

Referring to claim 60, Agnihotri and Inoue do not disclose a method of claim 1, wherein the predicted time change is based on time changes for previous programs that have titles similar to a title of the selected program.

In an analogous art, Herald teaches a method of claim 1, wherein the predicted time change is based on time changes for previous programs that have titles similar to a title of the selected program (column 1, lines 32-41).

At the time of the invention, it would have been obvious for one of ordinary skill in the art to note that channel 1 from figure 6A in Inoue could be broadcasting the baseball double header taught by Herald. This would mean that if baseball game ABC vs. XYZ went extra innings and ran over its allotted time slot that the following game would need its recording time adjusted using the prediction from Agnihotri. The motivation would have been that it would be beneficial to broadcast more sports to bring in more money from commercials inserted into the broadcasts.

Claim 65 is rejected on the same grounds as claim 60.

Referring to claim 61, Agnihotri does not disclose a method of claim 1, further comprising: receiving a first program from a media provider, wherein the first program is associated with a particular broadcast interval; detecting a change in the broadcast interval of the first program; and storing the change in the broadcast interval of the first program in memory in response to detecting the change.

In an analogous art, Inoue teaches a method of claim 1, further comprising: receiving a first program from a media provider, wherein the first program is associated with a particular broadcast interval; detecting a change in the broadcast interval of the first program; and storing the change in the broadcast interval of the first program in memory in response to detecting the change (figures 6A and 6B; column 8, lines 32-67).

At the time of the invention, it would have been obvious for one of ordinary skill in the art to add the method of modifying the recording of the adjacent program when the first program is extended. The motivation would have been that if a baseball game is extended, the program following the program would have to be clipped as there would be no way to record it fully without a second tuner.

Claim 66 is rejected on the same grounds as claim 61.

Referring to claim 62, Agnihotri does not disclose a method of claim 61, further comprising: determining whether the first program is related to the selected program; and retrieving change in the broadcast interval of the first program from memory in response to determining that the first program is related to the selected program,

wherein the predicted time change associated with the selected program is based on the retrieved change in the broadcast interval of the first program.

In an analogous art, Inoue teaches a method of claim 61, further comprising: determining whether the first program is related to the selected program; and retrieving change in the broadcast interval of the first program from memory in response to determining that the first program is related to the selected program, wherein the predicted time change associated with the selected program is based on the retrieved change in the broadcast interval of the first program (figures 6A and 6B; column 8, lines 32-67).

At the time of the invention, it would have been obvious for one of ordinary skill in the art to add the method of modifying the recording of the adjacent program when the first program is extended. The motivation would have been that if a baseball game is extended, the program following the program would have to be clipped as there would be no way to record it fully without a second tuner.

Claim 67 is rejected on the same grounds as claim 62.

Referring to claim 63, Agnihotri discloses a method of claim 61, wherein the broadcast interval of the first program includes a start time and an end time.

Claim 68 is rejected on the same grounds as claim 62.

Claims 13, 14, 16, 17, 42, and 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Agnihotri in view of Inoue as applied to the claims above, and further in view of Hoffberg.

Referring to claim 13, Agnihotri and Inoue do not disclose a method of claim 1 further comprising automatically selecting the recording start time.

In an analogous art, Hoffberg teaches a method of claim 1 further comprising automatically selecting the recording start time (column 62, lines 56-59).

At the time of the invention, it would have been obvious for one of ordinary skill in the art to add the automatic recording taught by Hoffberg to the method disclosed by Agnihotri and Inoue. The motivation would have been to enable the programs that the user prefers to be recorded without the user's intervention, therefore saving the user time.

Referring to claim 14, Agnihotri and Inoue do not disclose a method of claim 13 further comprising providing a user with an opportunity to select to have automatic selection of the recording start time.

In an analogous art, Hoffberg teaches a method of claim 13 further comprising providing a user with an opportunity to select to have automatic selection of the recording start time (column 62, lines 56-59).

At the time of the invention, it would have been obvious for one of ordinary skill in the art to add the automatic recording taught by Hoffberg to the method disclosed by Agnihotri and Inoue. The motivation would have been to enable the programs that the



user prefers to be recorded without the user's intervention, therefore saving the user time.

Claim 42 is rejected on the same grounds as claim 14.

Referring to claim 16, Agnihotri and Inoue do not disclose a method of claim 1 further comprising automatically selecting the recording end time.

In an analogous art, Hoffberg teaches a method of claim 1 further comprising automatically selecting the recording end time (column 62, lines 56-59).

At the time of the invention, it would have been obvious for one of ordinary skill in the art to add the automatic recording taught by Hoffberg to the method disclosed by Agnihotri and Inoue. The motivation would have been to enable the programs that the user prefers to be recorded without the user's intervention, therefore saving the user time.

Referring to claim 17, Agnihotri and Inoue do not disclose a method of claim 16 further comprising providing a user with an opportunity to select to have automatic selection of the recording end time.

In an analogous art, Hoffberg teaches a method of claim 16 further comprising providing a user with an opportunity to select to have automatic selection of the recording end time (column 62, lines 56-59).

At the time of the invention, it would have been obvious for one of ordinary skill in the art to add the automatic recording taught by Hoffberg to the method disclosed by

Agnihotri and Inoue. The motivation would have been to enable the programs that the user prefers to be recorded without the user's intervention, therefore saving the user time.

Claim 45 is rejected on the same grounds as claim 17.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Justin E. Shepard whose telephone number is (571) 272-5967. The examiner can normally be reached on 7:30-5 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Kelley can be reached on (571) 272-7331. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JS

/Annan Q Shang/  
Primary Examiner, Art Unit 2424